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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/674,812	11/08/2002	Bradley William Caprathe	PC17698 (PC17265)	5075

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EXAMINER	
LUNDGREN, JEFFREY S	

ART UNIT	PAPER NUMBER
1639	

DATE MAILED: 06/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/674,812	CAPRATHE ET AL.	
	Examiner	Art Unit	
	Jeff Lundgren	1639	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *28 July 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-5, 7-13 15-19* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-5,7-9 and 16-19* is/are rejected.

7)☒ Claim(s) *1-5,10-13 and 15* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Status of the Claims

Claims 1-5, 7-13 and 15-19 are pending in the instant application, and are the subject of the instant Office Action detailed below.

Claim Objections

Claims 1-5, 10-13 and 15, are objected. The claims are objected because it appears that Applicants have introduced a *significant* number of errors in filing their Amendment. For example, in amended claim 1, the chemical groups R^1 and R^2 define the structural feature "-$(CH_2)_n$-O-substituted aryl" on two separate occurrences. It appears that Applicants have made a typographical error in reproducing this set of claims because the previous set of claims filed as part of PCT application has the structural feature "-$(CH_2)_n$-S-substituted aryl" in place of the second occurrence of the duplicated limitation. Appropriate correction is required.

The following additional errors also require correction:

claim 5, chemical group R2, a comma is required after the group "–OH;"

claim 10, the first compound is missing at least one hyphen and an open parenthesis;

claim 10, the second compound erroneously identifies the bicycle-ring group as "[22.1];"

claim 10, the third compound erroneously introduces a space within the term "ylmethanesul fonylamino;"

claim 11, the sixth compound misspells the term "ethyl;"

claim 12, the seventh compound misspells the feature "propyrylcarbamoyl;"

claim 12, the eighth compound misspells the feature "hept-1-ylmethanesulfonylamino;"

claim 12, the ninth compound also misspells the feature "hept-1-ylmethanesulfonylamino;"

claim 13, the second compound misspells the feature "ethanoic acid;"

claim 13, the third compound misspells the feature "dimethyl-2-oxo;"

claim 15, omits a line-return following the first and third compounds;

claim 15, the sixth compound is misspelled as "[(2-Benzotfiazol-1-yl;"

claim 15, the eighth and ninth compounds omit a hyphen following the closed bracket, prior to the number "4."

In order to expedite prosecution, Applicants are required to *thoroughly* review and correct any typographical errors. In order for Applicants' reply to the Office Action to be considered complete, Applicants are required to provide a statement that such a review and correction has been completed.

Withdrawn Rejections

35 U.S.C. § 112, first paragraph:

The rejection of claims 18 and 19 under 35 U.S.C. § 112, first paragraph, for lack of enablement, is withdrawn for the reasons argued by Applicants.

Maintained Rejections

Double Patenting:

The rejection of claims 1-5, 7-9 and 16-19 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-28 of U.S. Patent No. 6,316,415, in view of WO 98/16502, is maintained for the reasons of record.

It is noted that Applicants do not challenge the "obviousness" conclusion based on the combination of art cited by the Examiner. Applicants first allege that the rejection is improper because their PCT application, which published as WO 98/16502, never issued as a U.S. patent, and therefore cannot be used in a double patenting rejection, and second allege that since this reference is "improper" for the aforementioned reasons that the U.S. patent cannot properly be used in the rejection. Applicants finally contend that the Examiner's reference to the disclosure of the U.S. patent is improper. Each of these arguments has been fully considered, but is found unpersuasive.

Applicants arguments fully miss the mark on the double patenting rejection. In determining whether a nonstatutory basis exists for a double patenting rejection, the first question to be asked is — does any claim in the application define an invention that is merely an obvious variation of an invention claimed in a U.S. patent? If the answer is yes, then an "obviousness-type" nonstatutory double patenting rejection may be appropriate. Obviousness-

type double patenting requires rejection of an application claim when the claimed subject matter is not patentably distinct from the subject matter claimed in a commonly owned patent, or a non-commonly owned patent but subject to a joint research agreement as set forth in 35 U.S.C. 103(c)(2) and (3), when the issuance of a second patent would provide unjustified extension of the term of the right to exclude granted by a patent. *See Eli Lilly & Co. v. Barr Labs., Inc.*, 251 F.3d 955, 58 USPQ2d 1869 (Fed. Cir. 2001); *Ex parte Davis*, 56 USPQ2d 1434, 1435-36 (Bd. Pat. App. & Inter. 2000).

A double patenting rejection of the obviousness-type is "analogous to [a failure to meet] the nonobviousness requirement of 35 U.S.C. 103" except that the patent principally underlying the double patenting rejection is not considered prior art. *In re Braithwaite*, 379 F.2d 594, 154 USPQ 29 (CCPA 1967). Therefore, any analysis employed in an obviousness-type double patenting rejection parallels the guidelines for analysis of a 35 U.S.C. 103 obviousness determination. *In re Braat*, 937 F.2d 589, 19 USPQ2d 1289 (Fed. Cir. 1991); In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985).

In the instant case, the rejection is grounded on Applicants U.S. patent claims, namely, U.S. Patent No. 6,316,415, ***in view of*** specific chemical equivalents for compounds that also serve as ICE inhibitors identified by WO 98/16502 (the suggestion to modify the claims of the U.S. patent with the teachings of the PCT is clearly laid out in careful detail in the previous Office Action.) Therefore, the rejection is based on an obvious variation of Applicants' already-patented chemical compounds, not a PCT application. Accordingly, both documents are properly used in the obvious-type double patenting rejection.

As stated before, Applicants have not challenged the combination of references and the Examiner's proper conclusion of obviousness.

With regard to the Examiner's reference to the disclosure of the U.S. patent, this reference merely illustrates the inherent properties possessed by the compounds, that is, that the compounds also share an affinity for ICE. Therefore, only the claims of the reference U.S. patent have been used in the rejection, not its disclosure.

Therefore, the rejection is proper and is maintained.

Conclusions

No claim is allowable.

Applicants' erroneous amendment necessitated the new grounds of claim objections presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

If Applicants should amendment the claims, a complete and responsive reply will clearly identify where support can be found in the disclosure for each amendment. Applicants should point to the page and line numbers of the application corresponding to each amendment, and provide any statements that might help to identify support for the claimed invention (*e.g.*, if the amendment is not supported *in ipsis verbis*, clarification on the record may be helpful). Should Applicants present new claims, Applicants should clearly identify where support can be found in the disclosure.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Jeff Lundgren whose telephone number is 571-272-5541. The Examiner can normally be reached from 7:00 AM to 5:30 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Peter Paras, can be reached on 571-272-4517. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JSL

PETER PARAS, JR.
PRIMARY EXAMINER

SPE1639